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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,643	07/17/2003	James A. Blackstone	PRG 0001 PA	1024

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EXAMINER

PIERCE, WILLIAM M

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/621,643	Applicant(s) BLACKSTONE, JAMES A.	
	Examiner William M. Pierce	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/7/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3, 6-16 and 18-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 6-16 and 18-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


WILLIAM M. PIERCE
Examiner
Art Unit 3711

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/15/2005</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION***Claim Rejections - 35 USC § 101***

The rejection of claims 1-32 for lack of utility has not been sustained in view of applicant's remarks.

Claims 3, 6-16 and 33 remain rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 3 and 6-16 pertain to indicia or a kit of indicia which as been held to be non-statutory by stating that a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See *In re Miller*, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); *Ex parte Gwinn*, 112 USPQ 439 (Bd. App. 1955); and *In re Jones*, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). These claims are drawn to a "substrate" in the form of a table of information to record and reference for information. What applicant has invented amounts to a "computer" to improved a bowler where markings on a bowling lane are entered (in tabular form) and results (placed in tabular form) are noted to provide data by which a bowler uses. A "computer" can be in paper form, as in the instant invention, or electronic form.

With respect to "computing" and printed matter, what constitutes a "functional relationship" is best stated in *In re Ngai*, 70 USPQ2d 1862 (Fed. Cir. 2004) In *Ngai*, the court found that there was no functional relationship present between the printed matter of the instructions and the kit by stating "the printed matter in no way depends on the kit, and the kit does not depend on the printed matter". As with the instant case, the existence of break point marks, target point marks and release point marks on a bowling lane and the method of using them does not depend upon how information is recorded an tabulated on a printed substrate. *Ngai* and *Gulack* decisions held the same basic premise of "where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability". In other words, merely placing indicia on a substrate that helps a player record and refer to for later use does not make a kit or method known in the art new.

The rejection of claims 8-32 has not been sustained in view of applicant's remarks and that the step of "bowling" is considered a physical step and has a practical application of helping a bowler improve.

Claim Rejections - 35 USC § 103

Claims 3, 6-16 and 18-33 are rejected under 35 U.S.C. 102(b) as anticipated by Brunswick Anvilane or, in the alternative, under 35 U.S.C. 103(a) as obvious over Complete Bowling index "Targeting Aids: The dots and

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arrows" (CB) in view of AMF and PRO TIPS: Cheryl Daniels and further in view of BowlingFans.com (Kegler"s) and Speed Control As set forth in the previous office action and below in response to applicant's remarks.

Applicant's initial argument is that the prior art is silent with respect to any table. However, under the grounds for 35 USC 103 such would have been obvious to one skilled in the art. Examiners position is supported by In re Ngai and Gulack (cited in the previous office action) where the process that differs from the prior art only with respect to nonfunctional descriptive material now placed in the form of a table which as been held incapable of altering the prior art process steps and how they are to be performed. As shown by the prior art, Bowler's use the arrows and dot, as well as break point markings, that are on the lane to observe and adjust their approach and release of a bowling ball to achieve more consistent targeting. Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process. In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986). In the instant case, the prior art structure show the use of release, target and break point markers on the alley. Their method of use is considered inherently obvious. Placing data in a tabular form is old and well known. While one can track and calculate in their head, providing a means for recording, calculating and displaying results make it easier and more convenient. As such to have place the known targeting methods in bowling in a tabular form to "compute" results would have been obvious in order to make it more convenient.

Conclusion

Applicant's arguments filed 10/7/05 have been fully considered but they are not persuasive for the reasons set forth above in the grounds for rejection.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication and its merits should be directed to William Pierce at E-mail address bill.pierce@USPTO.gov or at telephone number (571) 272-4414.

For **official fax** communications to be officially entered in the application the fax number is (703) 872-9306.

For **informal fax** communications the fax number is (703) 308-7769.

Any inquiry of a general nature or relating to the **status** of this application or proceeding can also be directed to the receptionist whose telephone number is (703) 308-1148.

Any inquiry concerning the **drawings** should be directed to the Drafting Division whose telephone number is (703) 305-8335.



WILLIAM PIERCE
PATENT EXAMINER